

REMARKS

Reconsideration of the objection and the rejections set forth in the Office Action dated May 31, 2005, is respectfully requested. The Examiner rejected claims 1-13. Applicant has cancelled claims 1-13 without prejudice and has added new claims 14-33. Accordingly, claims 14-33 remain pending in the application. No new matter has been added by these amendments as can be confirmed by the Examiner.

A. Angles et al. Does Not Disclose or Suggest the Use of a Database System that Records Interface Provider Identification Codes Included with Invalid Information Requests as Recited in New Claims 14-33.

In the Office Action, the Examiner rejected claims 1-13 under 35 U.S.C. § 103(a) as allegedly being rendered obvious by Angles et al., United States Patent No. 5,933,811, in view of Gerace, United States Patent No. 5,848,396. Applicant respectfully submits, however that, by failing to disclose each and every element of the new independent claims 14, 26, and 27, neither Angles et al. nor Gerace anticipates nor renders obvious new claims 14-33. Therefore, it is submitted that claims 14-33 are in condition for allowance.

In contrast to the system and method recited in new claims 14-33, Angles et al. does not disclose or suggest "providing [interface provider identification codes] to an invalid response database system if the incoming request comprises an invalid information request." Instead, Angles et al. teaches that advertisement audit information can be stored in an accounting database 72. See Angles et al. at Fig. 11; col. 15, ll. 65-67; col. 16, ll. 1-15. **The advertisement audit information** disclosed by Angles et al. stored by the accounting database 72 includes information regarding advertisements actually viewed by customers and **relates to valid information requests only**. See id.

At least one recited element of new claims 14, 26, and 27 therefore is totally missing from Angles et al. In accordance with M.P.E.P. § 2131, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or

inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). The disclosure of a claim element in a prior art reference, when relied upon to negate patentability, must also be clear and unambiguous. Further, “[t]he identical invention must be shown in as complete detail as contained in the...claim.” *Richardson v. Suzuki Motor Corp.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Furthermore, and uniquely important in this case is the requirement that the elements relied on in the prior art reference must be arranged as required by the claim. See *In re Bonds*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990).

Accordingly, since *Angles et al.* fails to disclose each and every element of independent claims 14, 26, and 27, claims 14-33 are not anticipated. Applicant therefore submits that claims 14-33 are in condition for allowance.

B. No Motivation Exists to Modify the Teachings of *Angles et al.* in a Manner that Precludes the Patentability of New Claims 14-33 Under 35 U.S.C. § 103.

In accordance with M.P.E.P. § 2142, the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. “To establish a *prima facie* case of obviousness, three basic criteria must be met.” (M.P.E.P. § 2143.) First, some suggestion or motivation in the prior art references or in the knowledge of one of ordinary skill in the relevant art must exist to modify or combine the references. Second, if the references are combined, a reasonable expectation of success must be shown. Then, finally, all of the claim limitations must be taught or suggested by one reference or a combination of references. To establish a *prima facie* case of obviousness based on a single reference that does not teach all the elements of a claim, the Examiner must provide a rationale for modifying the teachings of the reference. See *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000), *citing*, *B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp.*, 72 F.3d 1577, 1582, 37 U.S.P.Q.2d 1314, 1318 (Fed. Cir. 1996).

As discussed above, at least one recited element of claims 14-33 is totally missing from Angles et al. Further, the Examiner does not assert that any teaching or motivation exists in the prior art to modify Angles et al. in a manner that renders claims 14-33 obvious. The Examiner therefore has not established a *prima facie* case under 35 U.S.C. § 103 because, as shown above, all of the elements of the pending claims are not found in the cited reference. In fact, **Angles et al. “teaches away” from the use of an invalid response database system for recording interface provider identification codes included with invalid information requests** by disclosing an accounting database 72 for storing information relating to valid information requests only. See Angles et al. at Fig. 11; col. 15, ll. 65-67; col. 16, ll. 1-15. Angles et al. therefore does not provide a person skilled in the art with any motivation to use an invalid response database system for recording interface provider identification codes included with invalid information requests as recited in new claims 14-33.


According, it is submitted that Angles et al. does not render new claims 14-33 obvious. Applicant therefore asserts that claims 14-33 are in condition for allowance.

For at least the reasons set forth above, it is submitted that new claims 14-33 are in condition for allowance. A Notice of Allowance is earnestly solicited. The Examiner is encouraged to contact the undersigned at (650) 614-7660 if there is any way to expedite the prosecution of the present application.

Respectfully submitted,

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